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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,857	03/08/2004	Andreas Schuch	032301.371	1268
25461	7590	06/01/2006	EXAMINER	RAETZSCH, ALVIN T
SMITH, GAMBRELL & RUSSELL, LLP 1230 PEACHTREE STREET, N.E. SUITE 3100, PROMENADE II ATLANTA, GA 30309-3592			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/795,857	SCHUCH ET AL.
	Examiner Alvin T. Raetzsch	Art Unit 1754

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 March 2006.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 12-17 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-11 and 18-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-21 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

***Election/Restrictions***

1. Applicant's election of claims 2-11 & 18-21 in the reply filed on 3/6/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. With regard to the applicant's statement directed toward a rejoinder if the product claims are indicated as allowable, attention is directed to the following, which was presented in the previous office action:

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. **Claims 2-4, 8, 10, 18, & 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Klasen et al. (US 5,480,626) in view of Bush (US 5,236,992).

Klasen et al. teaches carbon black pellets that have a hardness of 10-50 grams (Claim 7d), an average diameter between 0.5 and 4 mm and a suitable diameter range (Claim 7a-b), and pre-dried moisture contents of 43-52% (Table 1).

Bush teaches carbon black pellets having a DBP of >100, a CDBP of >78, and a surface area of <70 m<sup>2</sup>/g (Table 3).

Klasen states that carbon blacks with properties in the range of 40-450 DBP and surface areas of 30-1200 are suitable for the disclosed pelletizing process. It therefore would have been obvious to someone of ordinary skill in the art to use the carbon blacks taught by Bush in the process taught by Klasen in order to achieve a carbon black pellet with specific properties. The intrinsic properties of the carbon black of Bush can be used to create a pellet with the extrinsic properties taught by Klasen in order to create a pellet with good flowability and dispersability.

Claims 8, 10, 18, & 20: Bush teaches using the carbon black pellets in rubber compositions for making hoses and belts.

The process limitations of claim 2 do not necessarily limit the product itself. Product-by-process claims can be defined by process limitation, but the patentability is based upon the product itself. The product is defined only by properties that would necessarily be imparted on the product. The product, as claimed, would have been obvious over the prior art as discussed above. When the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the applicant to come forward with evidence establishing an unobvious difference. See MPEP § 2113.

4. **Claims 5-7, 9, 11, 19, & 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Klasen et al. (US 5,480,626) in view of Vogler et al. (US 6,231,624).

Klasen et al. teaches carbon black pellets that have a hardness of 10-50 grams (Claim 7d), an average diameter between 0.5 and 4 mm and a suitable diameter range (Claim 7a-b), and pre-dried moisture contents of 43-52% (Table 1).

Vogler et al. teaches carbon black pellets having a DBP of 46, a CDBP of 44, and a surface area of 45 m<sup>2</sup>/g (Table 1, CB 5). Vogler teaches a hardness and average particle size slightly lower than claimed.

Klasen states that carbon blacks with properties in the range of 40-450 DBP and surface areas of 30-1200 are suitable for the disclosed pelletizing process. It therefore would have been obvious to someone of ordinary skill in the art to use the carbon blacks taught by Vogler in the process taught by Klasen in order to achieve a carbon black pellet with specific properties. The intrinsic properties of the carbon black of Vogler can be used to create a pellet with the extrinsic properties taught by Klasen in order to create a pellet with good flowability and dispersability.

Claims 9, 11, 19, & 21: Vogler and Klasen teach the use of carbon black pellets in rubber compositions. It is well known in the art to use such rubber compositions in articles such as tires, belts, and hoses.

The process limitations of claim 5 do not necessarily limit the product itself. Product-by-process claims can be defined by process limitation, but the patentability is based upon the product itself. The product is defined only by properties that would necessarily be imparted on the product. The product, as claimed, would have been obvious over the prior art as discussed above. When the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the applicant to come forward with evidence establishing an unobvious difference. See MPEP § 2113.

*Response to Arguments*

5. Applicant's arguments filed 3/6/06 have been fully considered but they are not persuasive.

With regard to the arguments directed towards the processes of the prior art, the claims are product claims and while product claims may be defined by process limitations, the patentability of a product defined by process claims is determined by the product properties and those that the process necessarily defines. The prior art can still read on the current claims without teaching the process limitations, as is the case here. The applicant must submit factual evidence showing a difference of the product over the prior art when the processes of making are different. Arguments are not a substitute for evidence. Attention is directed to MPEP 2113.

The applicant's statements that the properties of Bush are intrinsic are correct, as stated in this and the previous office action. This would give carbon black pellets made with the black of Bush these properties, hence the combination of Bush and Klasen. The applicant argues that Bush does not teach the pelletizing or handling of the black after production. This is correct, but does not invalidate the combination of the references. Bush leaves it open to palletize or handle the black after production to those methods known in the art, such as taught by Klasen. In addition, the applicant's motivation/benefit for making the claimed the product does not need to be predicted by the prior art. Any motivation for combining references that would have been obvious to one in the art is valid.

The arguments towards Vogler are misplaced. The applicant argues the pelletization process of Vogler, when in fact the rejection was based on the intrinsic properties of the carbon blacks made by Vogler and their use in the pelletization process of Klasen.

Again, the motivation to combine the references does not need to be based, nor was based, on the applicant's discovery of improved conveyance. The discovery of a

property, as argued extensively, does not preclude a case of *prima facie* obviousness based on alternate motivations. Klasen clearly teaches the range of intrinsic carbon black properties that are suited for their process, and the use of any blacks falling in those ranges is seen as obvious.

The table provided in the arguments does not address the rejections correctly. Vogler should be on the top row under carbon black formation as discussed above. The text of the table was discussed above.

### *Conclusion*

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning communications from the examiner should be directed to Alvin T. Raetzsch at 571-272-8164, normally 9-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, see <http://pair-direct.uspto.gov>, or contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). For assistance from a USPTO Customer Service Representative or the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ATR



STUART L. HENDRICKSON  
PRIMARY EXAMINER